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EXPLORING AMBIGUITY: TRADEMARK PROTECTION IN INTERNATIONAL TREATIES AND THE CHALLENGES OF NON-TRADITIONAL MARKS

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INTRODUCTION

Trademarks play a crucial role in promoting innovation and ensuring equitable competition in the global intellectual property market. The Madrid System, the TRIPS Agreement, and the Paris Convention are some of the international treaties that govern trademarks; nevertheless, they do not precisely define the scope of trademark protection.

Trademarks are dual by nature. In other words, it has both an international and a national dimension. While national laws provide the legislative, executive, and judicial branches necessary for protection on their territory, international instruments guarantee minimal levels of protection by supplying means for contracting states to enforce them. Throughout history, numerous multinational agreements and treaties have emerged to safeguard trademarks. Better protection of rights for different types of marks, harmonisation of laws, and an effective system for multilateral filing for global protection are the main goals of these international agreements influencing trademarks. This essay examines the challenges associated with protecting trademarks internationally, with a particular emphasis on the obstacles presented by non-traditional marks. As businesses experiment with new branding elements including sound, colour, fragrance, and motion marks, international treaties are becoming more and more significant.

PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, 1883

The Paris Convention¹, a cornerstone in the realm of international intellectual property law, was conceived with the objective of fostering cooperation among nations for the protection of

¹ The Paris convention was signed on 20th March 1883. Revised on 14th December 1990 at Brussels, on 2nd June 1911 at Washington, on 6th November 1925 at Hague, on 2nd June 1934 at London & on 14th July 1967 at Stockholm. It was amended last on 28th September 1979.

industrial property, including trademarks. While the Convention has been instrumental in aligning various national trademark systems, the determination of the precise scope of protection has proven to be a nuanced and evolving challenge. The Paris Convention upholds the principles of national treatment and the right of priority. Despite its fundamental principles, the Paris Convention does not provide a comprehensive definition of the scope of trademark protection. The absence of explicit guidelines regarding the types of marks covered, the duration of protection, and the specific criteria for infringement has led to divergent interpretations among member states. This lack of specificity has resulted in variations in the enforcement and recognition of trademarks, causing uncertainty for businesses operating internationally.

The Convention was crafted in an era vastly different from the modern complexities of trademarks, including non-traditional marks like sound, colour, and holograms. The challenge lies in reconciling the evolving nature of trademarks with the traditional framework established by the Convention. The Paris Convention outlines the framework for the protection of trademark rights but does not prescribe standardized enforcement mechanisms or remedies for infringement. Member states retain the discretion to establish their enforcement procedures, leading to disparities in the effectiveness of trademark protection and the remedies available to trademark owners.

MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

The Madrid system, which consists of the Madrid Protocol² and the Madrid Agreement³ combined, continues to take form as the most authoritative and generally recognised modern international agreement system for trademark registration internationally. The WIPO is in charge of both the agreement and the protocol. Simplifying the procedure of getting international trademark protection is the goal of the Madrid system.

The applicant may choose from the list of member nations when submitting an application to the national office in order to request mark protection. The international application's compliance

² The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (concluded 1989, entered into force 1995, became operative 1996).

³ The Madrid Agreement Concerning the International Registration of Trade Marks [concluded 1891, revised Brussels (1900), Washington (1911), The Hague (1925), London (1934), Nice (1957), Stockholm (1967), and amended in 1979].

with home state requirements and correspondence with the basic application is examined by the national office in the country of origin. After the national office is satisfied, the application is sent to WIPO. The mark is registered in the chosen member nations after all formalities, such as examination, advertisement for approval, and opposition, are completed. The protocol stipulates a 10-year registration term that may be renewed for an additional 10-year duration.

The trademark owner benefits from the Madrid system in a number of ways. An international registration can be obtained by filing a single application with the international bureau through the home country's office in one language and paying a single set of fees, as opposed to filing separate national applications in each country of interest, in multiple languages, in accordance with various national or regional regulations, and paying multiple plus higher fees. Another benefit is that all designated contractual parties just need to complete one procedural step to maintain and renew their registration. Consequently, the Madrid Protocol offers a practical and affordable means of acquiring trademark protection. Nevertheless, the system also has several drawbacks. It is important to note that the "Basic National Application" is a prerequisite for the international application under the Protocol. Therefore, in the event that the same is changed or refused, the international application will be automatically revised or denied.

The Madrid Agreement and Protocol traditionally required graphical representation for trademark registration. However, this criterion can be restrictive, especially for non-traditional marks. Recent developments, including amendments to the system, have aimed at addressing this limitation, allowing for a broader scope of protection that accommodates non-traditional marks. While the Madrid Agreement and Protocol have significantly simplified the process of obtaining international trademark protection, the determination of the scope of this protection remains a multifaceted issue. National autonomy, the graphical representation requirement, and the evolving nature of trademark law present challenges in achieving a standardized and comprehensive scope.

AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS)

The TRIPS Agreement, enacted in 1994, marked a significant milestone in the convergence of international intellectual property laws. Trademarks, as a vital subset of intellectual property, are subject to the provisions of TRIPS. The agreement specifies minimum protection requirements

for all categories of intellectual property that fall under its purview. In addition, it offers domestic processes and recourse options for the enforcement of intellectual property rights. The Agreement subjects issues arising between WTO Members over their TRIPS commitments to the dispute resolution processes of the WTO.⁴

Trademark protection regulations are outlined in TRIPS Articles 15 through 21. The principles outlined in Article 15 on the terms and content of trademark protection must be upheld by the member state. It gives a clear definition of a trademark, saying that any sign, or combination of signs, that can be used to identify the products or services of one business from the products or services of another business can be considered a trademark. This definition makes it very evident that the TRIPS accords allow for equal treatment for service marks that indicate services as well as trademarks associated with commodities. As per the TRIPS, it is clearly stated that signs that lack the inherent ability to differentiate relevant goods or services can be evaluated based on their acquired distinctiveness via use. Thus, as long as they do not deviate from the Paris Convention's provisions, the member state is free to refuse trademark registration for any other reason. The TRIPS agreement states that, whilst acknowledging the registration of a mark based on its use, actual trademark use is not a prerequisite for submitting an application for registration. Furthermore, it states that the member state must give a reasonable opportunity for applications of opposition or revocation of the trademark, either prior to registration or immediately following registration, and must publish the trademark.

TRIPS acknowledges the importance of distinctiveness in trademark protection. It also recognizes the protection of well-known trademarks beyond their country of origin. However, the agreement falls short of providing a uniform definition of distinctiveness or clear criteria for determining well-known status, leading to divergent interpretations and applications across jurisdictions. The TRIPS Agreement calls for effective enforcement mechanisms against trademark infringement, including counterfeiting. However, the agreement does not offer detailed guidance on the specific measures that member states should adopt. Consequently, there is a lack of uniformity in the enforcement practices, creating challenges for businesses seeking consistent protection across borders.

⁴ Joanna Schmidt Szalewski, 'The International Protection of Trademarks after the TRIPS Agreement' (1998) 9 Duke Journal of Comparative and International Law 189

NON-TRADITIONAL TRADEMARKS

Trademarks have historically only included words, symbols, designs, or combinations of these. Although there may be minor variations across nations, the range is generally consistent, and discussions about broadening it date back more than a century. Any trademark that does not fall within the traditional definition of word, symbol, or design, or a combination thereof, will be regarded as a non-traditional trademark. Because the term "non-traditional trademark" has such a broad connotation, using it to describe trademarks might be confusing.⁵ After analysing unconventional trademarks, the World Intellectual Property Organisation (WIPO) established the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT), a permanent committee tasked with researching trademarks, designs, and geographical indications. The SCT separated non-visual trademarks from visual trademarks.⁶ Visual trademarks include, but are not limited to, three-dimensional marks, colour marks, holograms, slogans, motion or multimedia signs, position marks, gesture marks, and book and movie titles. The following are thought to be included in this concept when it comes to non-visual trademarks: taste, texture, or feel; sound; and smell.

No agreement was reached on a definition of a trademark during the Paris Convention discussions, and the Convention stayed silent on whether trademark rights come from registration, use, or both, leaving it up to the national laws of the member nations. Under the leadership of AIPPI, the 1956 Congress of Washington decided it was premature to propose a general definition for trademarks. Discussions along these lines have place in Brussels (1954) and Vienna (1952). The scope of a mark is not definitively specified in the Madrid System Protocol and Agreement. The Madrid Agreement permits the registration of non-traditional marks such as "sound" could be covered.

A worldwide shift in trademark rights was brought about by the TRIPS Agreement of 1994, which introduced a broad definition in Article 15(1) that first highlights the trademarks' functional nature, which is based on their distinctiveness. This broad term includes a wide range of formats, including words, names, letters, numbers, figurative elements, and colour combinations. The fact that parties to the 1990 negotiations were unable to reach a consensus on a particular set of

⁵ R Carapeto, 'A Reflection About the Introduction of Non-Traditional Trademarks' (2016) 34 *Waseda Bulletin of Comparative Law*, 28

⁶ WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)

examples led to the definition's expansion. While the US, EU, and Japan proposed a more specific definition, non-visual trademarks are not expressly excluded by the TRIPS Agreement.⁷ The key provision in Article 15(1) is the fourth sentence, which gives member states the option to impose visual perceptibility requirements on applicants for registration. As a result, TRIPS does not require the protection of non-visual trademarks; rather, each member state is free to choose whether to do so. According to Article 15(1), non-visual trademarks should be protected if they fulfil a trademark purpose and have a distinctive character, which is in line with the functional approach of the TRIPS definition. Registration might not be necessary in order to protect these trademarks; instead, protection might go beyond trademark law and incorporate anti-competition statutes. In the course of discussions over the TRIPS Agreement, Bolivia put out a solution: if a visually non-visual trademark—such as sounds, smells, or three-dimensional shapes—can be graphically represented and has a distinctive character, it may be eligible for registration. Free Trade Agreements (FTAs) have led to an increase in the registration of new mark categories, including sounds, on a global scale. The US frequently promotes more extensive trademark protection in free trade agreements. For example, the US-Korea free trade agreement (Article 18.2) requires clearly that sound marks be protected, particularly in agreements with developing nations.

The Trade Marks Act, 1994, implemented in response to EU Directive 89/104/EEC, governs trademarks and registration in the UK and the Isle of Man. In 1994, Chanel's attempt to trademark the scent of Chanel No. 5 was rejected, as the fragrance and the product were considered inseparable⁸. Meanwhile, Sumitomo Rubber Co.'s scent of roses for their tires and Unicorn Products' smell of beer for their darts were accepted.⁹

Graphical representation is crucial in the EU for trademark acceptance. In the case of *Ralf Sieckmann v. Deutsches Patent und Markenamt*¹⁰, an application for scent trademarking was rejected due to insufficient graphical representation. The ECJ, relying on EU Directive 89/104/EEC, emphasized the importance of clear, precise, and accessible representation, leading to the establishment of the Sieckmann test. This test was later applied in cases such as *Apple Inc*

⁷ Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (Sweet & Maxwell, 2003) 167.

⁸ Nathan K G Lau, 'Registration of Olfactory Marks as Trademarks: Insurmountable Problems?' (2004) 16 *Singapore Academy Law Journal* 264, 265.

⁹ Sumitomo Rubber Co's Application No. 2001416, 31 October 1994.

¹⁰ Case C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt*. EU:C: 2002:748. [2002], ECR I-11737.

v. Deutsches Patent und Markenamt¹¹. In *Shield Mark BV v. Kist*¹², a landmark case, the ECJ ruled that aural marks could be trademarked if distinctive and graphically represented. Relying on EU Directive 89/104/EEC and the *Sieckmann* case, they specified that descriptions like "crow of a rooster" were insufficient, but representation through musical notes was acceptable. This decision, based on graphical representation, influenced judgments globally. However, with the removal of the graphical representation requirement in EU Trademark Directive 2015/2436 and EU Trademark Regulation 2015/2424, registration of unconventional marks, including those related to smell, taste, movement, touch, color, shape, and sound, has become more accessible.

CONCLUSION

While dynamic, the international trademark protection structure can be confusing at times. Important agreements like as the TRIPS Agreement, Madrid System, and Paris Convention offer a worldwide framework but are not definite in nature, particularly with regard to non-traditional trademarks. There are opportunities and problems in the ever-changing business landscape brought about by technologies like motion marks, colour, sound, and scent. For companies looking to get worldwide trademark recognition, the lack of clear criteria results in a jurisdiction-dependent approach that adds complexity. Emerging trends indicate a rising recognition of non-traditional marks, such as the removal of graphical representation restrictions in EU trademark law reforms. Balancing innovation and distinctiveness is delicate, and legal frameworks adapt to these changes. Businesses and legal professionals need to be aware of both local and global legal requirements in this complex environment. The possible harmonisation of worldwide standards may come into play in the future if non-traditional trademarks gain popularity. Ongoing discussions and adaptations are crucial for trademark protection to align with the evolving nature of 21st-century commerce.

¹¹ Case C-421/13 *Apple Inc v Deutsches Patent und Markenamt* [2014] ECLI:EU:C: 2014:302

¹² Case C-283/01 *Shield Mark BV v Kist* [2003] ECR I-10353

REFERENCE

- Paris Convention for The Protection of Industrial Property,1883
- The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks,1989.
- The Madrid Agreement Concerning the International Registration of Trade Marks,1891.
- Agreement on Trade-Related Aspects of Intellectual Property Rights,1994.
- Sumitomo Rubber Co's Application No. 2001416, 31 October 1994.
- Case C-273/00 Ralf Sieckmann v Deutsches Patent- und Markenamt. EU:C: 2002:748. [2002], ECR I-11737.
- Case C-421/13 Apple Inc v Deutsches Patent und Markenamt [2014] ECLI:EU:C: 2014:302
- Case C-283/01 Shield Mark BV v Kist [2003] ECR I-10353
- Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (Sweet & Maxwell, 2003).
- Joanna Schmidt Szalewski, 'The International Protection of Trademarks after the TRIPS Agreement' (1998) 9 Duke Journal of Comparative and International Law
- R Carapeto, 'A Reflection About the Introduction of Non-Traditional Trademarks' (2016) 34 Waseda Bulletin of Comparative Law.
- WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).
- Nathan K G Lau, 'Registration of Olfactory Marks as Trademarks: Insurmountable Problems?' (2004) 16 Singapore Academy Law Journal.